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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/526,664

03/04/2005

Ryoji Tsukamoto

Q86586

3144

23373 7590 12/11/2007
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EXAMINER

SASTRI, SATYA B

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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12/11/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/526,664

Applicant(s)

TSUKAMOTO, RYOJI

Examiner

Satya B. Sastri

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 3/4/05, 7/17/06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to application filed on March 4, 2005. Claims 1-15 are now pending in the application.

Specification

2. The use of the trademark (for tinting agents) has been noted in page 12, lines 3-21 and working examples of this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Objection

3. Claim 5 is objected to for reciting the Markush group incorrectly. When materials recited in a claim are so related as to constitute a proper Markush group, they may be recited in the conventional manner, or alternatively. For example, if "wherein R is a material selected from the group consisting of A, B, C and D" is a proper limitation, then "wherein R is A, B, C or D" shall also be considered proper. See MPEP § 2173.05(h).

Appropriate correction is required.

Claim Rejections - 35 USC § 102 and 103

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 5-7 are rejected under 35 U.S.C. 102(b) as anticipated by Ohmatsuzawa et al. (US 6,346,070).

Ohmatsuzawa et al. disclose catalysts for polyester production and process of producing polyester using the catalyst as well as uses of the polyester. The catalyst comprises a solid titanium compound (abstract).

The prior art additionally discloses the use of a tint adjusting agent added in the esterification step or the polycondensation step. The disclosed additives include Solvent Blue 104 and Solvent Red 135, Pigment Blue 29, Pigment Blue 15:1, Pigment Blue 15:3, Pigment Red 187 and Pigment Violet 19 (col. 8, lines 55-62).

The polyester produced may contain known additives such as stabilizer, release agents, antistatic agents, dispersants and colorants which may be added in any step of the process for producing polyester, or may be added by forming a masterbatch before molding. The polyesters, such as polyethylene terephthalate, may be used to make sheets, films, fibers and in particular, for making bottles (col. 39, lines 17-27).

Working examples 502-1 to 502-4 and 502-6 to 502-10 disclose polyesters comprising less than 10 ppm of a tint adjusting agent Solvent Blue 104 and/or Solvent Red 135, titanium compound and phosphorus compound in amounts that satisfy the ratio recited in claim 6 and devoid of cobalt metal element.

Given that the tinting agents fall within the realm of suitable tinting agents defined in instant specification on pages 11-12, the tint adjusting agents Solvent Blue 104 and/or Solvent Red 135 must inherently possess the properties recited in claim 1 as well as have the thermal stability as defined in claim 2. Therefore, the presently cited claims are anticipated by the prior art.

7. Claims 4, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson et al. (US 5,349,036).

The discussion with regard to Ohmatsuzawa et al. in paragraph 6 above is incorporated herein by reference.

The difference between the prior art and the instant invention is that the prior art does not exemplify polyester compositions comprising the specific tinting agents in the specified amounts and does not limit the concentration of element with specific gravity 5 or more to 10 ppm.

The primary reference is open to use of blue, red and violet pigments in the polyester compositions. It is the examiner's position that use of the disclosed dyes and/or pigments individually or as a combination or use of equivalent dyes individually or as combinations, would be well within the capabilities of a skilled artisan so as to fine tune the color requirements of the resultant polyester products. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize appropriately effective amount of tinting agent combinations including those within the scope of present claims so as to produce the desired end results since it has been deemed that the discovery of optimum values of result-effective variables in a known process is within the level of ordinary skill in the art. *In re Boesch*, 205 USPQ 215 (CCPA 1980).

With regard to claim 4, it is noted that the prior art discloses a variety of cocatalysts for use during polycondensation reaction. It is noted that the prior art open to use of a single cocatalyst or a combination of cocatalysts. Disclosed cocatalysts include zinc compounds and may be present such that the molar ratio of the metal atom in the cocatalyst to titanium is in the range of 1/50 to 50/1 (col. 27, lines 48-53, col. 15, lines 15-19, col. 16, lines 37-38). Thus, the presently recited limitation for the concentration of the metal atom, having a specific gravity of 5.0 or more, is within the disclosed range and would have been obvious to one of ordinary skill in the art absent evidence of unexpected results.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 6,346,070 used in the rejections set forth above is cited as the patent family member of EP 1013692, an X-reference in the International Search Report.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satya Sastri at (571) 272 1112. The examiner can be reached on Wednesdays and Fridays, 7AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273 8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Satya Sastri

SATYA SASTRI

December 7, 2007